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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,244	09/15/1999	MASATOSHI NAGANO	1232-4566	7154
7590 02/25/2004			EXAMINER	
MORGAN & FINNEGAN L L P			LEE, CHEUKFAN	
345 PARK AVENUE			ART UNIT	
NEW YORK, NY 10154			PAPER NUMBER	
			2622	9

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/396,244

Applicant(s)

Examiner

Cheekfan Lee

Group Art Unit

2622

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-17-03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 and 3-48 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 3, and 5-48 is/are allowed.
- ☒ Claim(s) 4 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Claims 1 and 3-48 are pending. Claims 1, 9-11, 17, 21-25, 34-37, and 45-48 are independent.
2. The indicated allowableness of claim 4 is withdrawn. Rejection(s) follow.
3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

After a careful review of the claim(s), the examiner found that claim 1 and claim 4 limitations can not coexist.

In claim 4, the function of the "control means" is in contradiction with the function of the control means of claim 1. In claim 1, the "control means" is "for controlling said scanning means to scan the original image irradiated with the invisible light, and **then** to scan the original image irradiated with the visible light. Also in claim 1, "when the original image is irradiated with the visible light, the original image is scanned in a rough scan ... and in a fine scan for scanning the original image under a required condition on the basis of information scanned in the rough scan." These claim languages are understood to mean that both rough scan and fine scan with visible light are performed **after** the scanning with invisible light. However, in claim 4, "said control means controls said scanning means to scan the original image irradiated with the invisible light **after the rough scan**, and then to make the fine scan." This limitation of claim 4

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means that the rough scan with visible light is performed **not after** the scanning with invisible light, which is in contradiction with the language of claim 1.

4. Claims 1, 3, and 5-48 are allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-9700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231


or faxed to:

(703) 872-9306

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.
Feb. 21, 2004


Cheukfan Lee